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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,898	03/12/2004	Rick Huffman	2503343-991100	8313
29585	7590	07/21/2006	EXAMINER	
DLA PIPER RUDNICK GRAY CARY US LLP 153 TOWNSEND STREET SUITE 800 SAN FRANCISCO, CA 94107-1907			GREENE, DANIEL LAWSON	
			ART UNIT	PAPER NUMBER
			3663	

DATE MAILED: 07/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/799,898	Applicant(s) HUFFMAN, RICK	
	Examiner Daniel L. Greene Jr.	Art Unit 3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 17-21, 24-35, 37-48 and 52-78 is/are pending in the application.
- 4a) Of the above claim(s) 25-33, 45, 46 and 52-78 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 17-21, 24, 34, 35, 37-44, 47 and 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

- 1. Applicant's amendment received 5/18/2006 has been thoroughly reviewed and ONLY the following Objections/Rejections from the previous Office action mailed 9/9/2005 have been overcome and are hereby withdrawn: ONLY Sections 2, 5, and 7-13.**
- 2. A review of the 5/18/2006 listing of claims indicates that claims 18 and 40 still contain limitations that were originally deleted in the initial amendment received 6/21/2004. This fact was previously brought to applicant's attention and accordingly claims 18 and 40 will be examined using the language set forth below. NOTE that the double strikethrough, underlined, bolded claim limitations below were originally deleted in said 6/21/2004 amendment. In response to this Office Action, Applicant is required to update the claim language of the claims to reflect the amendments already of record.**

Claim 18 (currently amended): A two-piece, two-stage, reduced energy, mechanically operating cartridge of reusable components for launching a bullet of non-lethal, ~~sub-lethal~~, or lethal composition from a dedicated or modified firearm including a step at the interface between the chamber and the barrel, comprising:

- (a) a piston sleeve comprising a substantially non-deformable reusable jacket defining a bullet cavity at a first Longitudinal end for coupling the

non-lethal bullet therein, and the second end for coupling with a primary case;

(b) the primary case comprising a substantially non-deformable reusable jacket for being axially coupled with the second end of the piston sleeve, and defining a primary case cavity for coupling with a propellant mechanism;

(c) complementary pairs of protruding portions (hereinafter "cogs") and channels for coupling the piston sleeve with the primary case, and

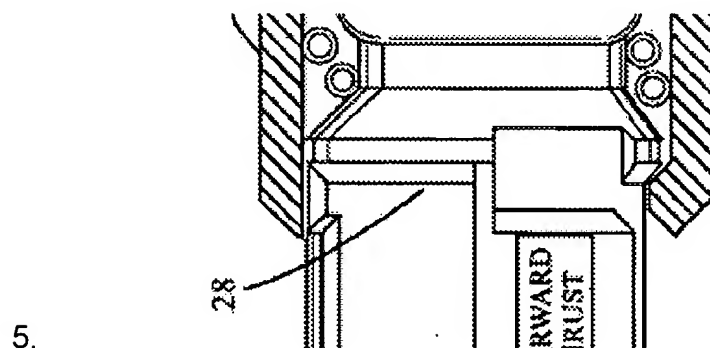
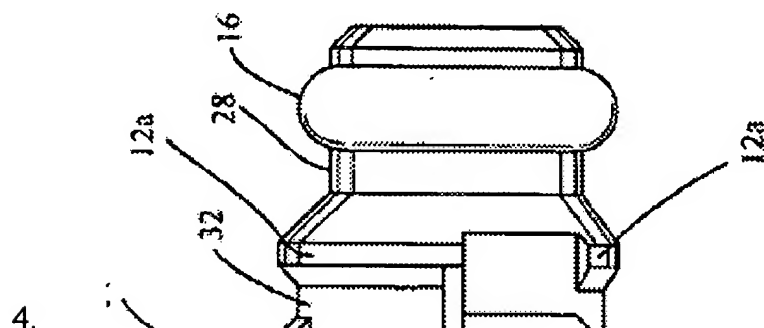
(d) wherein the piston sleeve comprises a shoulder such that upon activation when the piston sleeve and primary case are telescoping apart from a static position, a said shoulder of the piston sleeve contacts ~~an annular~~ a step between a chamber and a barrel of the a firearm preventing the sleeve from advancing down the barrel, and instead the primary case thrusts rearward away from the barrel.

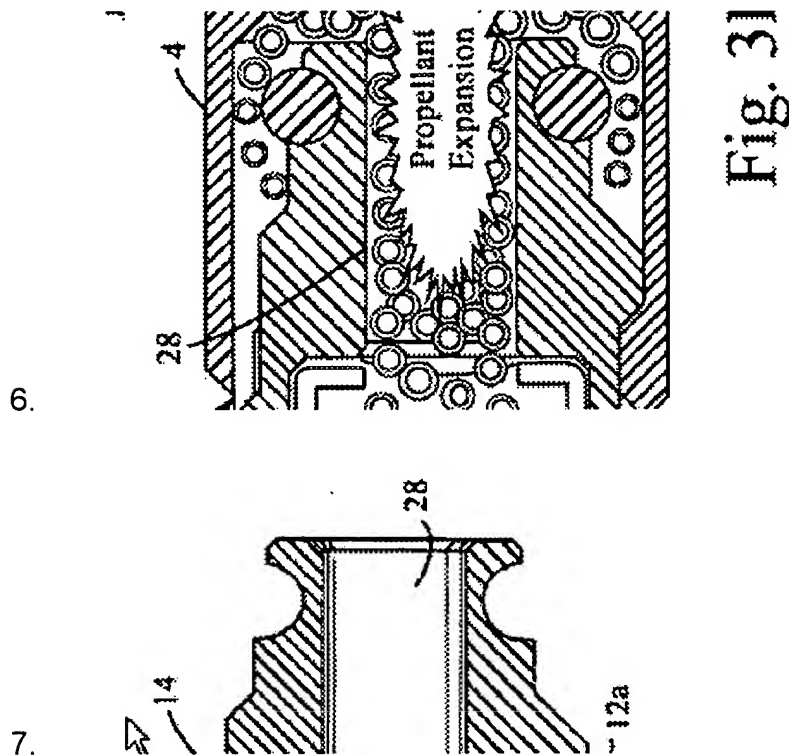
Claim 40 (currently amended): The cartridge of claim 34, wherein the piston sleeve comprises a shoulder ~~firearm includes a step between the chamber and the barrel~~ such that upon firing when the piston sleeve and primary case are telescoping from the static position, said a shoulder of the piston sleeve contacts a ~~the annular~~ step between a chamber and a barrel of a firearm preventing the sleeve from advancing down the barrel, and instead the primary case thrusts rearward away from the barrel.

Drawings

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3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) for the reasons set forth in section 3A of the previous office action mailed 9/9/2005. Applicant's amendment to the specification is acknowledged but appears to contain new matter as explained in more detail below. Further, amendment to the specification alone does not obviate the fact that the drawings must also be corrected as said Figures have indicia indicating different parts with the same number that cannot be overcome by only amending said specification as shown in more detail below.





A review of the manner in which the specification was amended, in order to define exactly what item 28 is, when referenced to the drawings, creates doubt as to what exactly applicant is attempting to define because item 28 is a narrow cylindrical portion (page 13, last line), however the specific metes and bounds of this cylindrical portion have not been set forth. It appears that according to at least figures 2B and 3B the narrow cylindrical portion extends almost half way from the beveled tip towards the third end portion 36, however according to Figure 1D it would appear the portion only extends from the beveled end to the cog portion.

8. The drawings are still objected to for the reasons set forth in sections 3A and 3B of the 9/9/2005 Office Action because it is still unclear exactly what applicant is defining as items 28 and 32.

Specification

9. The amendment filed 5/18/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is the amendments to the specification on pages 4-6 of said 5/18/2006 amendment regarding the attempt to overcome the objection to the drawings. For example:

A. On page 4 amending the specification at page 13, the paragraph starts as identifying item 32 as a channel, Applicant's amendment then redefines it as a second cylindrical insertion portion 32.

B. On page 4 amending the specification at page 14, the amendment adds new matter in that it is the volume of the combined cavities 50, 30 and 34 that expand, NOT 50 and 28 as item 50 is the primer cavity and item 28 in figure 3b is another cavity however their total volume is fixed. It appears it is the telescopic action that causes the case and sleeve to thrust rearward allowing the volume of cavities 30 and 34 to expand.

C. The rest of the amendments to the specification are also objected to as the drawings do not reflect what Applicant has amended the specification to say because Item 28 is still labeled as multiple items by the drawings themselves

Applicant is required to cancel the new matter in the reply to this Office Action.

**The text of those sections of Title 35, U.S. Code not included in this action
can be found in a prior Office action**

Claim Rejections - 35 USC § 112

10. Claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claim 44 is vague, indefinite and incomplete in what all is meant by and encompassed by the phrase "wherein the projectile is configured such that an interior of the sleeve includes a substantially right cylindrical shape" because it is not seen wherein the projectile has an interior sleeve, hence the metes and bounds of the claim are undefined.
- b. There is no proper antecedent basis for the term "the sleeve" in claim 44.

Claim Rejections - 35 USC § 102

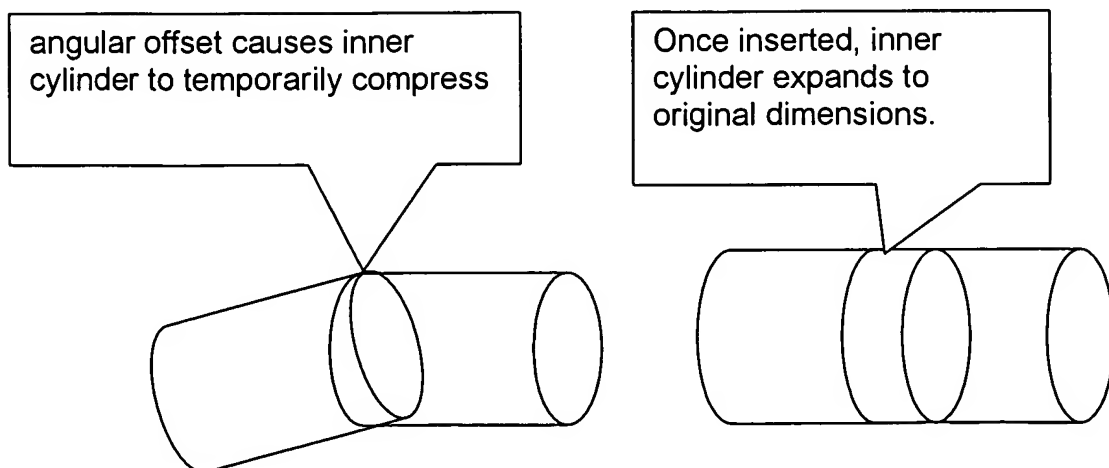
11. Claims 1, 8-14, 16-21, 24, 34, 35, 37-44, 47, 48 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,095,051 to Saxby for the reasons set forth in section 17 of the previous Office action mailed 9/9/2005.

Applicant's arguments filed 5/18/2006 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., partially annular) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further in this regard, the instant claim language is not closed ended, i.e. the claim states "comprising...one or more protrusion portions". Clearly enough protrusion portions would surround the entire piston sleeve just as in Saxby.

Applicant's arguments are unpersuasive as applicant has not shown that the references do not teach what the examiner has stated they teach, nor has applicant shown that the examiner's reasoning for and manner of combining the teachings of the references is improper or invalid. The difference in operation of the claimed invention does not alleviate the fact that the reference contains each and every limitation found in the instant claim language.

Further, although applicant states the assembly procedure of Saxby, there is no reason they cannot be assembled by relative angular offset and compression of the inner cylinder by for example;



Claim Rejections - 35 USC § 103

12. Claims 2-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,095,051 to Saxby as applied to claims above, and further in view of U.S. Patent 6,845,716 to Hussein et al. for the reasons set forth in section 19 of the previous Office action mailed 9/9/2005.

Applicant's arguments filed 5/18/2006 have been fully considered but they are not persuasive.

Applicant's arguments are unpersuasive as applicant has not shown that the references do not teach what the examiner has stated they teach, nor has applicant shown that the examiner's reasoning for and manner of combining the teachings of the references is improper or invalid.

Applicant is again directed to **Hussein column 6, lines 23-33** to show that it is known in the art to utilize "cogs" and "channels" for coupling various parts of cartridges.

13. Claims 1-14, 17-21, 24, 34-35, 37-44, 47-48 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saxby as applied to claims above 1, 8-14, 16-21, 24, 34, 35, 37-44, 47, 48 and 51 and further in view of Hussein et al as applied to claims 2-7 above for the reasons set forth in sections 11 and 13 above as well as sections 17 and 19 of the previous Office action mailed 9/9/2005.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene Jr. whose telephone number is (571) 272-6876. The examiner can normally be reached on Mon-Fri 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on (571) 272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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2006-07-17


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